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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/376,461	08/18/1999	DAVID WINDSOR RILLIE	1128.006A	6542

7590 03/28/2003  
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SUITE 3120  
SAN DIEGO, CA 92101

EXAMINER

STODOLA, DANIEL P

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/376,461

Applicant(s)  
Rillie

Examiner  
Daniel P. Stodola

Art Unit  
3634



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to ~~communication(s)~~ filed on Board decision of August 9, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above, claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

The following action is in response to the Board decision mailed August 9, 2002, Paper No. 12, in which the examiner's rejections of claims 1-4 and 6-9 were reversed. With respect to the rejections of claim 1, the Board stated on page 4 of the decision that the Section 102 rejection based on Chao et al was improper because:

“...in the absence of explanation in the specification, the drawings do not provide sufficient evidence from which to conclude that the flashing is seamless, and cannot be relied upon as the sole basis for this conclusion.”

Further, the Board stated on pages 7 and 8 of the decision that the Section 103 rejection based on DeBlock et al, Hoy et al and Strieter was improper because:

“...the fact that the flashing components are integral with one another does not establish that this attachment occurs without the presence of a seam”; “one of ordinary skill...would have been taught by Hoy that the DeBlock flashing could be formed of a single piece of seamless vacuum formed plastics material, but not that it be made of metal, much less seamless metal”; and “(t)here is no teaching in Strieter that this metal device is entirely seamless.”

Further with respect to the Section 103 rejection, the Board stated on page 9 of the decision:

“...we cannot agree with the examiner that it would have been obvious to make the DeBlock flashing of seamless metal construction, particularly in light of the appellant's *unanswered challenge to the examiner to produce evidence that it*

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*was known to manufacture such devices of metal without seams”* (emphasis added).

In view of the above comments by the Board and the fact that the examiner possesses specific knowledge of the existence of particular references which indicate nonpatentability of at least one of the appealed claims as to which the examiner was reversed, prosecution is being reopened for the purpose of entering the new rejection(s). In particular, the examiner knows of specific references which clearly teach the manufacture of a one-piece, seamless, metal flashing and which evidence the knowledge of such in the art since at least 1978.

#### ***Election/Restriction***

Claims 10-15 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 2 and affirmed in Paper No. 3.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Nagler et al.

In particular, Chao et al clearly disclose that the basic tubular skylight construction of a metal flashing, transparent dome and at least one skylight tube as set forth in claim 1 is notoriously old and well-known. Applicant's attention is directed to Fig. 1 and Col. 2, lines 35-38. The fact that the flashing is metal is clearly established in Col. 4, line 67. What Chao et al fail to disclose is that the metal flashing is seamless.

Nagler et al disclose a metal flashing unit per se for roofs and specifically teach the manufacture of such flashing unit as a unitary seamless structure so as to minimize the hazard of leakage. See Col. 2, lines 23-24 and lines 50-55. The potential for leakage around roof penetrating devices and the need to avoid such is a major historical concern in the art.

To one of ordinary skill in the art, it would have been obvious to provide the flashing unit of Chao et al as a seamless metal flashing unit as taught by Nagler et al so as to minimize the hazard of leakage.

Claims 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Nagler et al as applied to claim 1 above, and further in view of Deutsch.

Both Chao et al and Nagler et al teach that the curb of the flashing has a hollow frusto-conical shape. For example, see Fig. 1 of each reference. What neither Chao et al nor Nagler et al disclose is the provision of at least one rib formed with the skirt. However, Deutsch discloses a one-piece seamless metal flashing for skylight installations having ribs (15; 76) formed in the skirt

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of the flashing. The purpose of these ribs is to divert the flow of water and thus minimize leakage around the roof opening. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the flashing of Chao et al with ribs formed in the skirt as taught by Deutsch so as to divert water flow and minimize leakage around the roof opening. With respect to claim 4, note that the rib 15 is formed along the periphery of the skirt.

With respect to claims 6 and 8, it is noted that a “surface strengthening anomaly” is set forth in claim 6 and this “anomaly” is defined by claim 8 as being a “rib”. As advanced previously above, Deutsch teaches the provision of ribs formed in the skirt. It is readily apparent that upstanding ribs across an otherwise flat sheet increase the resistance of the sheet to bending in a direction across the ribs and thus “strengthens” the sheet. Accordingly, the ribs of Deutsch constitute the at least one “strengthening anomaly” broadly recited by claim 6 irrespective of what other purpose that they were provided for. Applicant should also note *In re Best et al*, 195 USPQ 430 (CCPA 1977) regarding the claiming of a function not explicitly disclosed by a reference.

Claims 1, 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Deutsch.

Chao et al clearly disclose that the basic tubular skylight construction of a metal flashing, transparent dome and at least one skylight tube as set forth in claim 1 is notoriously old and well-known. Applicant’s attention is directed to Fig. 1 and Col. 2, lines 35-38. The fact that the flashing is metal is clearly established in Col. 4, line 67. What Chao et al fail to disclose is that the metal flashing is seamless.

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Deutsch disclose a flashing assembly for use in skylight installations. The flashing assembly is clearly disclosed as being metal. See, e.g., page 3, lines 16-20. Further, the flashing assembly is clearly disclosed as being a one-piece seamless drawn metal member. See, e.g., page 7, lines 25-28. Deutsch also discloses the provision of ribs 15/beads 76 on the skirt portion. What Deutsch fails to explicitly disclose is the presence of a skylight tube depending downwardly from the flashing.

To one of ordinary skill in the art, it would have been obvious to provide the metal flashing assembly of Chao et al as seamless as taught by Deutsch so as to minimize the hazard of leakage as well as to utilize a manufacturing process that is not as time consuming. Further, it is well within the level of skill of one of ordinary skill in the art to utilize known features of the art for the purpose for which they are known.

With respect to claims 2 and 4, Deutsch discloses the provision of ribs 15/beads 76 on the skirt portion of the flashing. The purpose of these ribs is to divert the flow of water and thus minimize leakage around the roof opening. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the flashing of Chao et al with ribs formed in the skirt as taught by Deutsch so as to divert water flow and minimize leakage around the roof opening. With respect to claim 4, note that the rib 15 is formed along the periphery of the skirt.

With respect to claims 6 and 8, it is noted that a "surface strengthening anomaly" is set forth in claim 6 and this "anomaly" is defined by claim 8 as being a "rib". As advanced previously above, Deutsch teaches the provision of ribs formed in the skirt. It is readily apparent that

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upstanding ribs across an otherwise flat sheet increase the resistance of the sheet to bending in a direction across the ribs and thus “strengthens” the sheet. Accordingly, the ribs of Deutsch constitute the at least one “strengthening anomaly” broadly recited by claim 6 irrespective of what other purpose that they were provided for. Applicant should also note *In re Best et al*, 195 USPQ 430 (CCPA 1977) regarding the claiming of a function not explicitly disclosed by a reference.

Alternatively, claims 1, 2, 4, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsch in view of Chao et al.

Deutsch disclose a flashing assembly for use in skylight installations. The flashing assembly is clearly disclosed as being metal. See, e.g., page 3, lines 16-20. Further, the flashing assembly is clearly disclosed as being a one-piece seamless drawn metal member. See, e.g., page 7, lines 25-28. Deutsch also discloses the provision of ribs 15/beads 76 on the skirt portion. What Deutsch fails to explicitly disclose is the presence of a skylight tube depending downwardly from the flashing.

Chao et al clearly disclose that the basic tubular skylight construction of a metal flashing, transparent dome and at least one skylight tube as set forth in claim 1 is notoriously old and well-known. Applicant’s attention is directed to Fig. 1 and Col. 2, lines 35-38. The fact that the flashing is metal is clearly established in Col. 4, line 67. What Chao et al fail to disclose is that the metal flashing is seamless.

It would have been obvious to one of ordinary skill in the art to utilize the flashing of Deutsch in a skylight installation that includes at least one skylight tube depending downwardly



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therefrom as taught by Chao et al because such tube is a conventional part of a skylight for connecting the roof opening to the ceiling of a room so as to direct light entering the roof opening into the room.

With respect to claims 2 and 4, Deutsch discloses the provision of ribs 15/beads 76 on the skirt portion of the flashing. The purpose of these ribs is to divert the flow of water and thus minimize leakage around the roof opening.

With respect to claims 6 and 8, it is noted that a “surface strengthening anomaly” is set forth in claim 6 and this “anomaly” is defined by claim 8 as being a “rib”. As advanced previously above, Deutsch teaches the provision of ribs formed in the skirt. It is readily apparent that upstanding ribs across an otherwise flat sheet increase the resistance of the sheet to bending in a direction across the ribs and thus “strengthens” the sheet. Accordingly, the ribs of Deutsch constitute the at least one “strengthening anomaly” broadly recited by claim 6 irrespective of what other purpose that they were provided for. Applicant should also note *In re Best et al*, 195 USPQ 430 (CCPA 1977) regarding the claiming of a function not explicitly disclosed by a reference.

Claims 3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al in view of Deutsch as applied to claims 1, 2, 4, 6, and 8 above, and further in view of Clark et al.

With respect to claims 3, 7 and 9, the formation of ribs in sheet material is notoriously old and well-known per se for such reasons as to stiffen a large sheet surface and permit the use of metal of lesser thickness and weight. Additionally, ribs are sometimes provided merely to

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introduce elevation changes for aesthetic purposes. Clark et al are evidence of such widely known knowledge. In particular, Clark et al disclose a sheet metal element and teach the provision of stiffening ribs (17) to the sheet metal element. The stiffening ribs (17b) are oriented radially on the sheet element. To one of ordinary skill in the art, it would have been obvious to provide the skirt of Chao et al with radially oriented stiffening ribs as apperceived by the teaching of Clark et al for the purpose of stiffening the skirt while also permitting the use of a skirt of lesser thickness and weight, producing no new and unexpected results.

Claims 3, 7 and 9 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Deutsch in view of Chao et al as applied to claims 1, 2, 4, 6, and 8 above, and further in view of Clark et al.

With respect to claims 3, 7 and 9, the formation of ribs in sheet material is notoriously old and well-known per se for such reasons as to stiffen a large sheet surface and permit the use of metal of lesser thickness and weight. Additionally, ribs are sometimes provided merely to introduce elevation changes for aesthetic purposes. Clark et al are evidence of such widely known knowledge. In particular, Clark et al disclose a sheet metal element and teach the provision of stiffening ribs (17) to the sheet metal element. The stiffening ribs (17b) are oriented radially on the sheet element. To one of ordinary skill in the art, it would have been obvious to provide the skirt of Deutsch with radially oriented stiffening ribs as apperceived by the teaching of Clark et al for the purpose of stiffening the skirt while also permitting the use of a skirt of lesser thickness and weight, producing no new and unexpected results.

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### *Specification*

It is noted that page 8 of the specification appears to seek to include subject matter into the specification that was not in applicant's possession at the time of filing and otherwise advance positions otherwise not consistent with existing patent law and case law. For example, the attempt to incorporate subject matter into this application via a generalized reference to an "incorporation by reference" without identification of such subject matter to be incorporated or identification of the particular patent, application, publication, etc., containing the desired subject matter is improper. See, page 8, lines 1-4. See MPEP 608.01(p) for the guidelines governing a proper incorporation by reference of subject matter. Further, the phrase "means for" is not required before the sixth paragraph of Section 112 can be invoked. It would appear that most, if not all, of the statements set forth on page 8 should be deleted or reworded. Appropriate correction is required.

### *Conclusion*

Arnold et al are cited to show a seamless flashing with ribs/corrugations formed in the skirt portion, e.g., see Figs. 1-3. Schlütter et al are cited to show another seamless flashing, e.g., see Figs. 1 and 2. Japanese Patent No. 58-24056 is cited to show the provision of rib formations (11) along the periphery of the flashing skirt. Hoy et al ('624) are cited for ribs 32. Comstock et al are cited for the provision of ribs (20, 22, 24, 30) to permit the use of metals of lesser weight

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and thickness, e.g., see Col. 1, lines 50-51. Denny is cited to teach the provision of strengthening ribs (12,14). MacKay, Jr. is cited for reinforcing ribs 32, 34.

The continued presence of claims 10-15 drawn to an invention non-elected without traverse in Paper No. 2 and affirmed in Paper No. 3 is noted. These claims will have to be canceled prior to the instant application being passed to issue.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P. Stodola whose telephone number is 703-308-2686.

The fax phone number for the organization where this application or proceeding is assigned is 703-305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



STODOLA  
March 18, 2003



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